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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,692	07/19/2005	Andres Miescher	71829	1914
23872 7590 06/24/2008 MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227				
			EXAMINER FERGUSON SAMRETH, MARISSA LIANA	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 06/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/542,692

**Applicant(s)**

MIESCHER ET AL.

**Examiner**

MARISSA L. FERGUSON-SAMRETH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-12 and 14-22 is/are pending in the application.  
4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 5-12 and 14-17 is/are rejected.  
7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly added claims 18-22 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 18-22 are divided into a plurality of combinations such as combination of claims 1 and 19, combination of claims 8 and 20-22, and combination of claims 11 and 18. The invention of each of these combinations or groups and the inventions of the combinations or groups formed by the previous claims are directed to related inventions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a materially different design and/or effect as evidenced by the recited, mutually exclusive characteristics of such groups, i.e., the invention of Claim 2 is directed to a device with a pneumatic adjusting element while the invention of claim 19 is directed to a device for varying nip ratio. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

2. Claim 1 links inventions from the group including new claim 19 and the groups including previous claims 2, 3, 5, 6, and 7. Claim 8 links inventions from the group including new claims 20-22 and the groups including previous claims 9 and 10. Claim 11 links inventions from the group including new claim 18 and the groups including previous claims 12, 14, 15, 16, 17 and 18. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claims, claims 1, 8 and 11. Upon the indication of allowability of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise requiring all the limitations of the allowable linking claims will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that require all the

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limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. 1.142 (b) and M.P.E.P. 821.03.

### ***Claim Objections***

3. Claims 1 -7, 19 and 20 are objected to because of the following informalities: In line 14, "base unit" should be -- basic unit-- . Appropriate correction is required.
4. Claim 1 recites the limitation "said first mating cylinder" in lines 7, 9 and 10 and "said second mating cylinder" in lines 7-10. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically regarding claim 8, the limitations "guiding the roller in the circumferential direction" and "moving the roller in a direction tangential..." appear to define the same process. (Note: until the claim is clarified the examiner will examine the claims based on the interpretation as stated above).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-9, 11, 12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Koppelkamm et al. (US Patent 5,806,428).

Regarding claims 1 and 11, Koppelkamm et al. teaches a first mating roller (5), a second mating roller (6) having a circumferential surface defining a second mating roller tangential direction, an engagement roller (7) for engaging and/or disengaging with or from the first mating roller and for engagement with the second mating roller, a basic unit, with which the roller can be moved to or away from the first mating roller in the circumferential direction of the second mating roller (refer to figure on page 6 of detailed

action), wherein the basic unit connected to the roller (7) via the feed unit (refer to figure on page 6 of detailed action), the basic unit is for guiding the roller together with the feed unit in the circumferential direction of the second mating roller and is adjustable in position for moving the engagement roller (7) in a direction parallel to the second mating roller tangential direction (note: the limitation is functional language, therefore the basic unit in the prior art has the capability of performing the intended function) and is in contact with the second mating roller, a feed unit (refer to figure on page 6 of the detailed action), the roller (7) being mounted on the feed unit and the feed unit being positionable in a bisecting line position with a rotational axis of said roller mounted on a bisecting line that bisects an angle between said first mating cylinder and said second mating cylinder (refer to figure on page 6 of the detailed action) and the feed unit for generating engaging pressure with which, in said bisecting line position, wherein the roller acts approximately uniformly on said first mating cylinder and said second mating cylinder such that a nip ratio between said first mating cylinder and said second mating cylinder is approximately equal (note: the limitation is functional language, therefore the feed unit in the prior art has the capability of performing the intended function).

Regarding claims 2 and 12, Koppelkamm et al. wherein the basic unit has a pneumatic adjusting element (13).

Regarding claim 3, Koppelkamm et al. teaches wherein the basic unit is adjustable in parallel to a tangential direction of the second mating roller for deflecting the feed unit from the bisecting line position to vary the nip ratio between the first mating cylinder (3) and the second mating cylinder (1) to generate a greater nip width

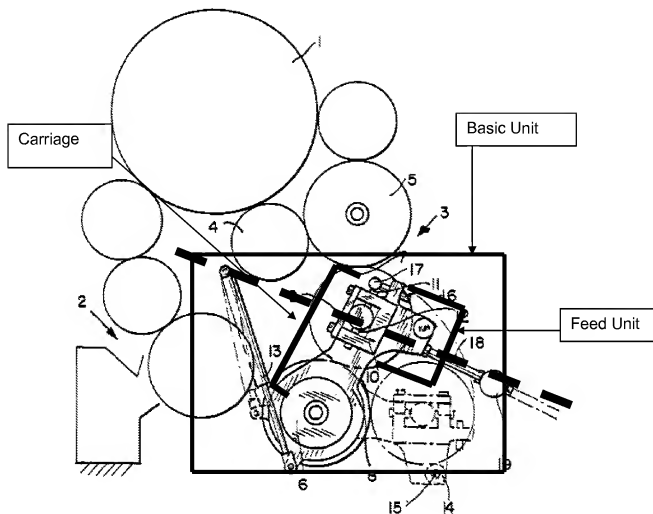
between one of the first mating cylinder and said roller and the second mating cylinder and the roller (note: the limitation is functional language, therefore the basic unit in the prior art has the capability of performing the intended function).

Regarding claims 5 and 15, Koppelkamm et al. teaches a spring element (13) for generating the engaging pressure of the roller.

Regarding claims 6 and 16, Koppelkamm et al. teaches a setting element for setting the engaging pressure (Column 2, Lines 29-38).

Regarding claims 7 and 17, Koppelkamm et al. teaches wherein the roller is mounted in a carriage (refer to figure on page 5 of the detailed action).

Regarding claim 8, Koppelkamm et al. teaches a process for engaging and/or disengaging a roller of a printing press with or from a first mating roller, wherein the roller is engaged with a second mating roller and guiding the roller in the circumferential direction of the second mating roller in the state in which it is engaged with the second mating roller (Column 2, Lines 29-60) and moving the roller in a direction tangential to an outer surface of the second mating roller.



Regarding claim 9, Koppelkamm et al. teaches wherein the roller (7) is continuously in contact with the second mating roller (Figure 1).

Regarding claim 14, Koppelkamm et al. teaches a feed unit, with which an engaging pressure can be generated on at least one of the mating rollers (refer to figure above).



7. Claims 1-3, 5-12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Heimlicher (US Patent 3,934,508).

Regarding claims 1 and 11, Heimlicher teaches mating rollers (1,5,32), an engagement roller (7) for engaging and/or disengaging with or from the first mating roller and for engagement with the second mating roller (Abstract and Column 5, Lines 15-60), a basic unit (refer to figure on page 10) with which the roller (7) can be moved to or away from the first mating roller (1) in the circumferential direction of the additional mating rollers (5, 32 and refer to figure 10), a feed unit, the roller (7) being mounted on the feed unit (refer to figure on page 10 of the detailed action), feed unit being positionable in a bisecting line position (refer to figure on page 10 of the detailed action) with a rotational axis of the roller mounted on a bisecting line that bisects an angle between the first mating cylinder and the second mating cylinder, the feed unit for generating engaging pressure with which, in the bisecting line position, the roller acts approximately uniformly on the first mating cylinder and the second mating cylinder such that a nip ratio between the first mating cylinder and said second mating cylinder is approximately equal (note: the limitation is functional language, therefore the basic unit in the prior art has the capability of performing the intended function), a basic unit connected to the roller via the feed unit (refer to figure on page 10 of the detailed action), the basic unit for guiding the roller together with the feed unit in the circumferential direction of the second mating roller, with the base unit the roller can be moved to or away from the first mating roller in the circumferential direction of the second mating roller whereby the roller may be maintained in contact with said second

mating roller equal (note: the limitation is functional language, therefore the basic unit in the prior art has the capability of performing the intended function).

Regarding claims 2 and 12, Heimlicher wherein the basic unit has a pneumatic adjusting element (11, 11a).

Regarding claim 3, Heimlicher teaches wherein the basic unit can be adjusted in parallel to a tangential direction of the second mating roller (Figure 5).

Regarding claims 5 and 15, Heimlicher teaches a spring element (12) for generating the engaging pressure of the roller.

Regarding claims 6 and 16, Heimlicher teaches a setting element for setting the engaging pressure (Column 3, Lines 12-40 and Column 4, Lines 10-39).

Regarding claims 7 and 17, Heimlicher teaches wherein the roller (7) is mounted in a carriage (refer to figure on page 10).

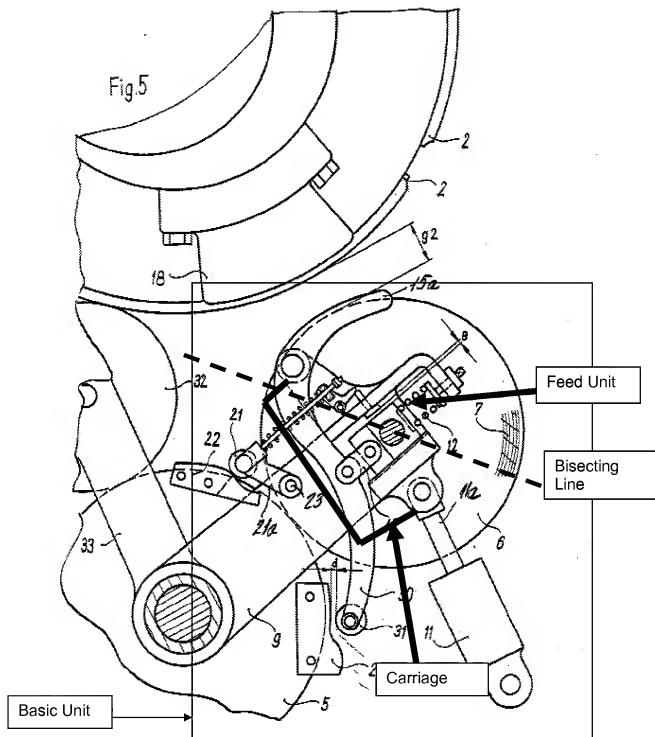
Regarding claim 8, Heimlicher teaches a process for engaging and/or disengaging a roller of a printing press with or from a first mating roller, wherein the roller is engaged with a second mating roller and guiding the roller in the circumferential direction of the second mating roller in the state in which it is engaged with the second mating roller and moving the roller in a direction tangential to an outer surface of a second mating roller (Abstract and Column 5, Lines 15-60).

Regarding claim 9, Heimlicher teaches wherein the roller (7) is continuously in contact with a mating roller (5).

Regarding claim 10, Heimlicher teaches wherein a nip, a nip ratio or the engaging pressure is set in the state in which the two mating rollers are engaged (5, 32) by said step of moving the roller in a direction tangential to an outer surface of the second mating roller.

Regarding claim 14, Heimlicher teaches a feed unit (refer to figure on page 9), with which an engaging pressure can be generated on at least one of the mating rollers (Abstract and Column 5, Lines 15-60).

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8. Claims 8-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jahn (US Patent 5,081,927).

Regarding claim 8, Jahn teaches guiding the roller (2) in the circumferential direction of the second mating roller (1) in the state in which the roller is engaged with the second mating roller, and moving the roller in a direction tangential to an outer surface of the second mating roller (Column 4, Lines 13-21, Figures 1,4).

Regarding claim 9, Jahn teaches wherein the roller (2) is continuously in contact with the second mating roller (element 1 and Figures 1, 4).

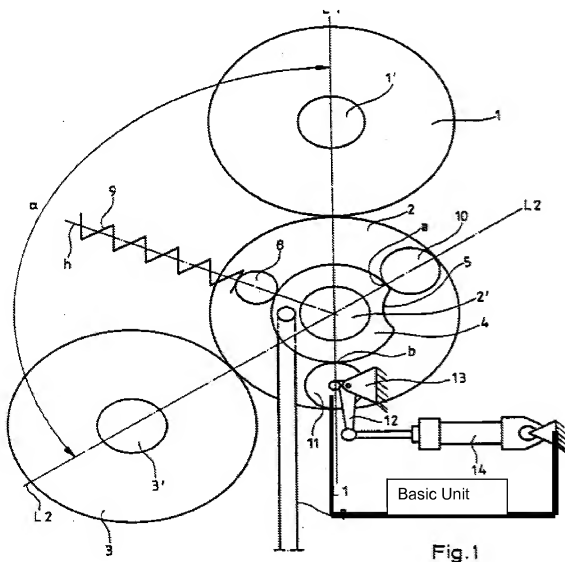
Regarding claim 10, Jahn teaches wherein a nip, a nip ratio or the engaging pressure is set in the state in which the two mating rollers are engaged by a step of moving the roller in a direction tangential to an outer surface of the second mating roller (Figure 1).

Regarding claim 11, Jahn teaches a first mating roller (3), a second mating roller (1) having a circumferential surface defining a second mating roller tangential direction, an engagement roller (2) and for engagement with the second mating roller (figures 1 and 4), a basic unit (refer to figure on page 13 of the detailed action) with which the roller (2) can be moved to or away (Figure 5) from the first mating roller (3) in the circumferential direction of the second mating roller, wherein the basic unit (refer to figure on page 13 of the detailed action) being adjustable in position for moving the engagement roller (2) in a direction parallel to the second mating roller tangential direction (Column 3, Lines 65-68 and Column 4, Lines 12).

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Regarding claim 12, Jahn teaches wherein the basic unit has a pneumatic adjusting element (14).

Regarding claim 14, Jahn teaches a feed unit (refer to figure on page 13 of the detailed action), with which an engaging pressure can be generated on at least one of the mating rollers.



***Response to Arguments***

8. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARISSA L. FERGUSON-SAMRETH** whose telephone

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number is (571)272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Judy Nguyen/  
Supervisory Patent Examiner, Art Unit 2854

MARISSA FERGUSON-  
SAMRETH  
Examiner  
Art Unit 2854

MFS